THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 83

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

JAMES N. ESSERMAN and PAUL MORONEY,

Junior Party,[1]

v.

KEITH B. GAMMIE

Senior Party.[2]

Patent Interference No. 104,001

[1] Patent No. 5,111,504, issued May 5, 1992, based on Application 07/568,990, filed August 17, 1990. Esserman et al.'s § 1.602(b) notice (Paper No. 8) identifies the assignee of the Esserman et al. patent as Next Level Systems, Inc. PTO records show that the name of the assignee was subsequently changed to General Instrument Corporation.

[2] Involved on two cases:
(a) Patent No. 5,029,207, issued July 2, 1991, based on Application Serial No. 07/473,442, filed May 4, 1993; and
(b) Application 08/056,795, filed May 4, 1993, for reissue of Patent No. 5,029,207.
Gammie's § 1.602(b) notice (Paper No. 4) identifies Scientific-Atlanta, Inc., as the assignee of Gammie's patent and reissue application.

JUDGMENT UNDER 37 CFR 1.662(c)

METZ, PATE, and MARTIN, Administrative Patent Judges.

MARTIN, Administrative Patent Judge.

As a result of the Adminstrative Patent Judge's decision (Paper No. 81) granting Esserman et al.'s Motion II and order (Paper No. 82) redeclaring the interference, the only claims of the Esserman et al. patent that remain designated as corresponding to the count are claims 60 and 68. Esserman et al.'s Motion X, which was contingent on the granting of their Motion II, requests entry of the accompanying statutory disclaimer of these claims under 37 CFR § 1.321(a) claims. This request is being treated as a request for entry of adverse judgment against these claims in accordance with the last sentence of § 1.662(c), which reads, "A statutory disclaimer will not be treated as a request for entry of an adverse judgment against the patentee unless it results in the deletion of all patent claims corresponding to a count."[3] Accordingly, judgment is hereby entered against

[3] The validity of this provision was upheld in Guinn v. Kopf, 96 F.3d 1419, 1422, 40 USPQ2d 1157, 1160 (Fed. Cir. 1996).

Esserman et al.'s patent claims 60 and 68, which means Esserman et al. are not entitled to a patent including those claims.[4] Judgment is therefore awarded in favor of Gammie's claims that correspond to the count (i.e., reissue application claims 16-20, 22, 35-43, 49, 50, 56, and 58 and patent claims 16-20, 22, 35-43, 49, 50, 66, and 58), which means Gammie is entitled to a patent including those claims.

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_____)
ANDREW H. METZ)
Administrative Patent Judge)
)
) BOARD OF
_____) PATENT APPEALS
WILLIAM F. PATE, III) AND
Administrative Patent Judge) INTERFERENCES
)
)
_____)
JOHN C. MARTIN)
Administrative Patent Judge)

[4] This judgment makes entry of the statutory disclaimer unnecessary.

cc:

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